

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re Examination of)	DECISION ON PETITION
)	FOR REVIEW OF DIRECTOR'S
)	FINAL DECISION UNDER
)	37 CFR § 10.2(c)
)	

I

Petitioner asks the Commissioner to review a decision of the Director of the Office of Enrollment & Discipline (OED) dated February 21, 1992, denying relief on request for regrade of the morning section of the registration examination held on August 21, 1991. The Director's decision has been reviewed. The relief requested is denied.

II

In the request for regrade dated February 5, 1992, petitioner urged that choice "a" in response to Question 14 of the morning section of the examination of August 21, 1991, could reasonably be considered a correct response. Question 14 asks, however, for the "most appropriate response to overcome this rejection". According to OED, the most appropriate response to Question 14 is "c". In the alternative, petitioner urged the Director to eliminate Question 14 from his examination because he believes it is ambiguous in light of 37 CFR § 1.62(e), MPEP 201.06(b), and MPEP 1490 considered together.

III

Question 14 and answers "a" and "c" read as follows:

14. You have filed a file-wrapper-continuation application (FWC) for your client. In the parent application, the examiner made an obviousness type double patenting rejection. In response to the rejection, you filed an acceptable terminal disclaimer which overcame the rejection. In the FWC, the examiner made the same obviousness type double patenting rejection. The most appropriate response to overcome this rejection would be to:

- a) File a response which refers the examiner to the previously filed terminal disclaimer.
- c) File a new terminal disclaimer and the appropriate fee.

IV

In accordance with 37 CFR § 1.321(b):

A terminal disclaimer, when filed in an application to obviate a double patenting rejection, must be accompanied by the fee set forth in § 1.20(d) and include a provision that any patent granted on that application shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection. (Emphasis added.)

Complying with § 1.321(b) under the circumstances outlined in Question 14, an appropriate official effectively terminally disclaimed application serial no. A, the application in which

the terminal disclaimer in question was filed. Upon filing new FWC application serial no. B, parent application serial no. A was abandoned. In order to effectively disclaim the terminal portion of any patent issuing from FWC application serial no. B, 37 CFR § 1.321(b) requires that the terminal disclaimer refer to FWC application serial no. B. A disclaimer of the terminal portion of any patent issuing from abandoned parent application serial no. A is not an acceptable response to an obviousness type double patenting rejection of subject matter claimed in FWC application serial no. B under 37 CFR § 1.321(b). Therefore, the Director of OED correctly decided on reconsideration:

The . . . choice a) is not the correct answer. A new terminal disclaimer must be filed because the original disclaimer will have identified only the parent application by serial number, and not the FWC application. Since the FWC application is assigned a new serial number, a new terminal disclaimer will be required to identify the FWC.

In accordance with 37 CFR § 1.62(e) and MPEP 201.06(b), the Patent and Trademark Office directs the use of the contents of the parent application in its FWC application. However, petitioner errs in suggesting that a paper found acceptable for disclaiming the terminal portion of any patent issuing from a

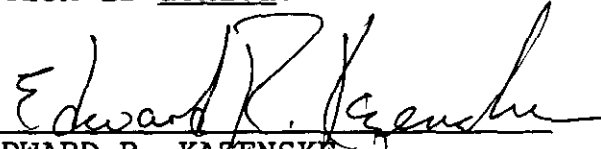
parent application, even if useful and used for some other purpose in its FWC application, would be also found acceptable for disclaiming the terminal portion of any patent issuing from its FWC application. The terminal portion of any patent issuing from the designated abandoned parent application only will have been disclaimed regardless of where the terminal disclaimer sits. Authorized officials must declare anew their intent to disclaim valuable patent rights in the FWC application. Furthermore, note that claims in the parent may be or may yet be amended in the FWC application.

V

The relief requested on petition is denied.

Date:

13 April 1992


EDWARD R. KAZENSKE
Director of
Interdisciplinary Programs

cc: